UNITED STATES PATENT AND TRADEMARK OFFICE

MN

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,685	12/31/2003	George Fitzmaurice	1500.1083	1979

21171   7590   07/16/2007
STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER
NGUYEN, LE V

ART UNIT	PAPER NUMBER
2174	

MAIL DATE	DELIVERY MODE
07/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/748,685	FITZMAURICE ET AL.
	Examiner	Art Unit	
	Le Nguyen	2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *30 April 2007*.

2a) ☐ This action is **FINAL**.　　2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-27* is/are pending in the application.

　　4a) Of the above claim(s) *19-24 and 26* is/are withdrawn from consideration.

5) ☒ Claim(s) *8 and 17* is/are allowed.

6) ☒ Claim(s) *1-7,9-16,18,25 and 27* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a) ☐ All　b) ☐ Some *　c) ☐ None of:

　　　1. ☐ Certified copies of the priority documents have been received.

　　　2. ☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3/16/07 and 4/30/07*.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

1.   This communication is responsive to an amendment filed 4/30/07.

2.   Claims 1-27 are pending in this application; and, claims 1, 4, 6, 8, 17-19 and 24-27 are independent claims. Claims 1, 4, 6, 15, 18, 25 and 27 have been amended; claims 8 and 17 have been allowed; and, claims 19-24 and 26 have been withdrawn from consideration.

3.   The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

4.   Claims 1-5, 18, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Screen Dumps of Macromedia Flash MX ("Macromedia Flash") in view of Buxton et al. ("Buxton").

As per claim 1, although Macromedia Flash teaches a layer editor interface wherein a graphic element comprises a layer representation graphic having layer names (figs. 2-4; *e.g. "Layer 1" and "square"*) and a pop-up menu control activatable for each layer from within the layer representation and that allows the layer to be edited (figs. 2-4; *for each layer, controls such as controls 38 and 40 are activatable, from within the layer representation, to display a pop-up menu such as pop-up menu 50*), Macromedia Flash does not explicitly disclose the activation being one of pressing a left mouse button and pressing a pen tip. Buxton teaches activation of a pop-up menu being one of pressing a left mouse button and pressing a pen tip (col.11, lines 37-42;

activation via pressing a pen tip). It would have been obvious to an artisan at the time of

the invention to incorporate the method of Buxton with the modified method of

Macromedia Flash in order to assist users who have not yet memorized the pen strokes

required to activate the menu.

As per claim 2, the modified Macromedia Flash teaches a layer editor interface

comprising a graphical representation having layer names (Macromedia Flash: figs. 2-4;

e.g. "Layer 1" and "square") and a pop-up menu control activatable for each layer, the

layer editor interface further comprising performing selection or operations with

underlying menus where a) activation of a control via a click selects a corresponding

layer, and b) execution of another click selects an operation on the layer (Macromedia

Flash: figs. 2-4; *i.e. activation of a control via a "click" selects a corresponding layer for*

an editing operation on the layer). Macromedia Flash further teaches performing

selections or operations with underlying menus where a mark simultaneously selects a

graphical representation and selects an operation on the graphical representation

(Buxton: fig. 11; col. 9, lines 27-28 and 56-67).

As per claim 3, the modified Macromedia Flash teaches a layer editor interface

wherein the marking menu control includes selections for new layer (Macromedia Flash:

figs. 2-4; page 3; *"Insert > Layer"),* rename layer (Macromedia Flash: figs. 2-4; page 1;

"Properties"), delete layer (Macromedia Flash: figs. 2-4; page 1; *"Delete Layer"),* merge

layer (Macromedia Flash: figs. 2-4; page 3; *wherein the active layer is combined with*

the layer below the active layer so that the content of the layers are combined), lock

layer (Macromedia Flash: figs. 2-4), hide layer (Macromedia Flash: figs. 2-4) and

position layer (Macromedia Flash: figs. 2-4; page 2; *comprises a mode in which*

dragging on the layer itself moves the currently selected layer in 2 dimensions). The

modified Macromedia Flash teaches an additional selection that includes clearing the

contents of the active layer (Macromedia Flash: figs. 2-4; *via Edit > Cut or Edit > Clear*

selection). The modified Macromedia Flash does not explicitly disclose additional

selections to be included in the pop-up menu/marking menu control. Official Notice is

taken that including additional selections within a pop-up menu/marking menu control is

well known in the art. It would have been obvious to an artisan at the time of the

invention to incorporate additional selections to be included in the pop-up menu/marking

menu control with the method of the modified Macromedia Flash so that the number of

items in the menu can be increased while still permitting rapid selection of the menu

items.

As per claim 4, although Macromedia Flash teaches a layer editor interface

comprising layer representation graphics having layer names and selection targets with

a box shape (figs. 2-4; *depicted are layer names with a box shape such as layer box 26,*

"Layer 1" and "square") and controls associated with the representation graphics that

are coincident with the targets (fig. 2; *controls 38 and 40*), Macromedia Flash does not

explicitly disclose the activation being one of pressing a left mouse button and pressing

a pen tip. Buxton teaches activation of a pop-up menu being one of pressing a left

mouse button and pressing a pen tip (col.11, lines 37-42; *activation via pressing a pen*

tip). It would have been obvious to an artisan at the time of the invention to incorporate

the method of Buxton with the modified method of Macromedia Flash in order to assist

users who have not yet memorized the pen strokes required to activate the menu.

As per claim 5, the modified Macromedia Flash teaches a layer editor interface

wherein a status indicator overlaps the selection targets (Macromedia Flash: figs. 2-4;

menu target area overlap status indicators such as status indicator 30 (or lock icon, not

shown)).

As per claim 18, although Macromedia Flash teaches a layer editor comprising a

linear list of layers and a menu accessible and activatable from within the layer list and

providing layer editing functions (Macromedia Flash: figs. 2-4; pages 1-3; *for each layer,*

controls such as controls 38 and 40 are activatable, from within the layer representation,

to display a pop-up menu such as pop-up menu 50), Macromedia Flash does not

explicitly disclose the activation being one of pressing a left mouse button and pressing

a pen tip (marking type). Buxton teaches activation of a pop-up menu being one of

pressing a left mouse button and pressing a pen tip (marking type) (col.11, lines 37-42;

activation via pressing a pen tip). It would have been obvious to an artisan at the time of

the invention to incorporate the method of Buxton with the modified method of

Macromedia Flash in order to assist users who have not yet memorized the pen strokes

required to activate the menu.

As per claim 25, although Macromedia Flash teaches an apparatus comprising a

display and a processor displaying a layer editor interface on the display, the interface

comprising a layer representation graphic having a user entered graphic name (figs. 2

and 4; page 1) and a corresponding coincident control (figs. 2 and 4; *"Properties" menu*

item), Macromedia Flash does not explicitly disclose the activation being one of

pressing a left mouse button and pressing a pen tip. Buxton teaches activation of a pop-

up menu being one of pressing a left mouse button and pressing a pen tip (col.11, lines

37-42; *activation via pressing a pen tip*). It would have been obvious to an artisan at the

time of the invention to incorporate the method of Buxton with the modified method of

Macromedia Flash in order to assist users who have not yet memorized the pen strokes

required to activate the menu.

As per claim 27, although Macromedia Flash teaches a layer editor interface

comprising layer representation graphics representing graphic layers having displayed

layer names descriptive of the content of the layers and a menu control associated with

each layer that allows the layer to be edited (figs. 2-4; *for each layer, controls such as*

controls 38 and 40 are activatable, from within the layer representation, to display a

pop-up menu such as pop-up menu 50), Macromedia Flash does not explicitly disclose

the activation being one of pressing a left mouse button and pressing a pen tip. Buxton

teaches activation of a pop-up menu being one of pressing a left mouse button and

pressing a pen tip (col.11, lines 37-42; *activation via pressing a pen tip*). It would have

been obvious to an artisan at the time of the invention to incorporate the method of

Buxton with the modified method of Macromedia Flash in order to assist users who

have not yet memorized the pen strokes required to activate the menu.

5.   Claims 6, 7, 9 and 11-16 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Screen Dumps of Macromedia Flash MX ("Macromedia Flash") in

view of Bernstein et al. ("Bernstein"), and further in view of Buxton et al. ("Buxton").

As per claim 6, although Macromedia Flash teaches an interface comprising layer representation graphic having layer names inputable by a user and displayable (figs. 2 and 4; page 1) and a control associated with the representation graphic activable from within the layer representation and that allows a corresponding layer to be edited (figs. 2-4; *for each layer, controls such as controls 38 and 40 are activatable, from within the layer representation, to display a pop-up menu such as pop-up menu 50*), Macromedia Flash does not explicitly disclose input by a user that is displayable as hand drawn strokes. Bernstein teaches input by a user that is displayable as hand drawn strokes (Abstract; figs. 10-11). It would have been obvious to an artisan at the time of the invention to incorporate the method of Bernstein with the method of Macromedia Flash given that pen-based systems are particularly well-suited for mobile users due to the ease of use and portability of pen peripherals and that handwritten ink are often times more recognizable to the user of the pen-based system, given that handwriting recognition software are prone to errors.

Macromedia Flash and Bernstein still do not explicitly disclose the activation being one of pressing a left mouse button and pressing a pen tip. Buxton teaches activation of a pop-up menu being one of pressing a left mouse button and pressing a pen tip (col.11, lines 37-42; *activation via pressing a pen tip*). It would have been obvious to an artisan at the time of the invention to incorporate the method of Buxton with the modified method of Macromedia Flash and Bernstein in order to assist users who have not yet memorized the pen strokes required to activate the menu.

As per claim 7, the modified Macromedia Flash teaches an interface comprising:

a drawing dialog box invoked by the control and allowing the user to input the layer

names (Macromedia Flash: figs. 2-4; page 1; Bernstein: sections [0039]-[0041]).

As per claim 9, the modified Macromedia Flash teaches an interface wherein the

control invokes a menu of a layer editing menu type (Macromedia Flash: figs. 2-4,

pages 1-3). The modified Macromedia Flash further teaches a menu being of a marking

menu type (Buxton: fig. 11; col. 9, lines 27-28 and 56-67).

As per claim 11, the modified Macromedia Flash teaches an interface wherein

each layer control comprises a pop-up menu control for layer editing comprising

·performing selection or operations with underlying menus where a) activation of a

control via a click selects a corresponding layer, and b) execution of another click

selects an operation on the layer (Macromedia Flash: figs. 2-4; *i.e. activation of a*

control via a "click" selects a corresponding layer for an editing operation on the layer).

The modified Macromedia Flash further teaches a marking menu that performs

selections or operations with underlying menus where a mark simultaneously selects a

graphical representation and selects an operation on the graphical representation

(Buxton: fig. 11; col. 9, lines 27-28 and 56-67) as well as a graphical representation

having layer names and additional controls associated with the graphical representation

such as a move control for moving a position of a layer in a layer editor stack

(Macromedia Flash: figs. 2-4; *via a drag operation in the timeline*) and a transparency

control controlling the transparency of a corresponding drawing layer (Macromedia

Flash: figs. 2-4; *via Windows > Panel > Effect*).

As per claim 12, the modified Macromedia Flash teaches an interface wherein each layer graphic has an indicator indicating whether a corresponding drawing layer is hidden or visible (Macromedia Flash: figs. 2-4; *in the eye icon column, indicators "·" indicate that the layers are visible*).

As per claim 13, the modified Macromedia Flash teaches an interface wherein each layer graphic has an indicator indicating whether a corresponding drawing layer is one of hidden or locked (Macromedia Flash: figs. 2-4; *from left to right, first "·" (depicted) indicator indicates that the layers are visible, while " X " (not shown) indicator indicates that the layers are hidden; and, second "·" indicator (depicted) indicates that the layers are unlocked, while a lock icon indicator (not shown) in place of the "·" indicator indicates that the layers are locked*).

As per claim 14, the modified Macromedia Flash teaches an interface wherein a background layer has a text label (Macromedia Flash: fig. 4; *background layer "Layer 2"*).

As per claim 15, the modified Macromedia Flash teaches an interface comprising a graphical representation having layer names (Macromedia Flash: figs. 2-4; *e.g. "Layer 1" and "square"*) and a pop-up menu control activatable for each layer, the layer editor interface further comprising performing selection or operations with underlying menus where a) activation of a control via a click selects a corresponding layer, and b) execution of another click selects an operation on the layer (Macromedia Flash: figs. 2-4; *i.e. activation of a control via a "click" selects a corresponding layer for an editing operation on the layer*). The modified Macromedia Flash further teaches performing

selections or operations with underlying menus where a mark simultaneously selects a

graphical representation and selects an operation on the graphical representation

(Buxton: fig. 11; col. 9, lines 27-28 and 56-67).

As per claim 16, the modified Macromedia Flash teaches an interface wherein

making a marking gesture in association with the layer representation graphic initiates a

function with respect to one or more of the layers (Macromedia Flash: figs. 2-4, pages

1-3; Bernstein: section [0039]).

6.   Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Screen

Dumps of Macromedia Flash MX ("Macromedia Flash") in view of Bernstein et al.

("Bernstein") and Buxton et al. ("Buxton") as applied to claim 6, and further in view of

Tosey.

As per claim 10, although the modified Macromedia Flash teaches an interface

wherein an active layer is highlighted with shading surrounding the name (Macromedia

Flash: figs. 2-3), the modified Macromedia Flash does not explicitly disclose highlighting

with a frame surrounding the name. Tosey teaches highlighting with a frame

surrounding a name (fig. 1; paragraph [0002]; *element 100*). It would have been obvious

to an artisan at the time of the invention to incorporate the method of Tosey with the

method of the modified Macromedia Flash as an implementation preference for

emphasizing objects that have focus.

Response to Arguments

7.   Applicant's arguments with respect to claims 1, 4, 6, 10, 11, 18, 25 and 27 have

been considered but are moot in view of the new ground(s) of rejection, except for the

following:

Applicant argued the following:

(a) A prima facie case of anticipation or obviousness has not been established

given that the Macromedia reference were created after the present application was

filed.

(b) There is no motivation to combine Macromedia Flash with Buxton.

(c) Justification for combining Bernstein with macromedia Flash is based on

impermissible hindsight and without sufficient motivation.

The Office disagrees for the following reasons:

Per (a), the Office has given applicant visuals as an aide for features already

embodied in Macromedia Flash as of 3/14/2002. In particular, Macromedia Flash

automatically provides default names for layers and allows user to name and/or rename

the layers, which has been corroborated via the supplemental visual aides and

documents generated from the software and are available for viewing and printing under

the "Help" menu of the toolbar (depicted in figs. 2-7 and described in the Office action

are a plurality of editing tools; also included are the printed Help documents).

Per (b) and in response to applicant's argument that there is no suggestion to

combine the references, the examiner recognizes that obviousness can only be

established by combining or modifying the teachings of the prior art to produce the

claimed invention where there is some teaching, suggestion, or motivation to do so

found either in the references themselves or in the knowledge generally available to one

of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case,

the teaching, suggestion, or motivation to do so was found in the references themselves

(Buxton: col. 9, lines 27-28).

Per (c), in response to applicant's argument that the examiner's conclusion of

obviousness is based upon improper hindsight reasoning, it must be recognized that

any judgment on obviousness is in a sense necessarily a reconstruction based upon

hindsight reasoning. But so long as it takes into account only knowledge which was

within the level of ordinary skill at the time the claimed invention was made, and does

not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA

1971).

Furthermore, in response to applicant's argument that there is no suggestion to

combine the references, the examiner recognizes that obviousness can only be

established by combining or modifying the teachings of the prior art to produce the

claimed invention where there is some teaching, suggestion, or motivation to do so

found either in the references themselves or in the knowledge generally available to one

of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case,

In this case, the teaching, suggestion, or motivation to do so was found both in the

references themselves and in the knowledge generally available to one of ordinary skill

in the art (Bernstein: section [0006]; knowledge available to one of ordinary skill in the

art as acknowledged by Bernstein background teaching).

Inquires

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Examiner Lê Nguyen whose telephone number is **(571)**

272-4068. The examiner can normally be reached on Monday - Friday from 7:00 am to

3:30 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kristine Kincaid, can be reached at (571) 272-4063.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

LVN
Patent Examiner
June 24, 2007

KRISTINE KINCAID
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100